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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/337,667 06/22/99 SASAKI

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MM91/0122
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EXAMINER

YOCKEY, D

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 01/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/337,667

Applicant(s)

SASAKI ET AL.

Examiner

David Yockey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2000 and 20 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6-11, corresponding dependancies of claim 12, and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and corresponding dependancies of claim 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Election/Restrictions

Claims 6-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

Claim Objections

Claims 12/1, 12/2/1, 12/3/1, 12/4/3/1 and 12/5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The apparatus as claimed, while being intended to perform the claimed method, is not required to perform the method. Accordingly, the apparatus claim could conceivably be infringed without infringing the method defined in the claims upon which these claims depend. See MPEP 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12/1, 12/2/1, 12/3/1, 12/4/3/1 and 12/5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The structure of the claimed apparatus is wholly undefined. The intended use of the apparatus does not define structure. See *In re Collier*, 158 USPQ 266 (CCPA 1968).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 12/1 and 12/3/1 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Takanashi et al. (US 4527171).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 4-5, 12/2/1, 12/4/3/1 and 12/5/1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takanashi et al. (US 4527171) in view of Fujimura et al. (US 5,397,763).

Takanashi et al. teaches the claimed invention except the cushion layer and the protective layer being formed as claimed.

Fujimura et al. teaches formation of a cushion layer formed between the surface of the recording paper and the image receiving layer in physical contact with the surface of the recording paper (column 7, line 45 through column 8, line 11; see in particular column 7, lines 48-52, which indicate the physical contact by endowing the cushion layer with adhesiveness instead of providing an adhesive layer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a cushion layer on the outer layer side of the image receiving layer 4b on thermal binder transfer sheet 4 in Takanashi et al. for the purpose of improving sharpness of the transferred image.

Fujimura et al. further teaches provision of a protective layer on a transferred image to protect the image from damage (column 10, lines 62-66; column 11, line 58 through column 12, line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a protective layer on the image recorded surface in Takanashi et al. for the purpose of protect the transferred image from damage.

Response to Arguments

Applicants' arguments filed 4 August 2000 have been fully considered but they are not persuasive.

Applicants argue that Fujimura et al. is non-analogous art. This argument is not persuasive because Fujimura et al. is not limited to transfer of a "pre-printed" image. Column 13, lines 7-19 clearly suggest use of a thermal head capable of changing the heating region corresponding to the input signals. Accordingly, both Applicants' disclosed invention and Fujimura et al. are analogous as both are incremental printers which transfer toner by selective application of heat. Further, the elected claims do not define the manner in which the image is transferred, but instead pertain to a subcombination of the disclosed invention pertaining to manipulation of particular layers. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that transferring toner onto an image forming layer differentiates claim 1 from Fujimura et al. To the extent that this argument has a bearing upon the instant invention, this argument is not persuasive. Figure 6A shows transferring the image forming layer onto the recording medium, and Figure 6B shows transferring toner onto the image forming layer.

Applicants argue that the Fujimura et al. cushion layer is not in physical contact with the recording layer (medium?), citing Figure 6A and the presence of an adhesive layer between the cushion layer and recording medium as evidence. This argument is not persuasive. Applicants attention is directed to column 7, lines 48-52, which indicates the physical contact by endowing the cushion layer with adhesiveness instead of providing an adhesive layer.

Applicants' remaining arguments are deemed to be moot in view of the new grounds of rejection or withdrawal of claims from consideration in accordance with Applicants' election responsive to the restriction requirement.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Yockey whose telephone number is (703) 308-3084. The examiner can normally be reached on all weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on (703) 308-0750. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703)305-3432 for regular communications and (703)305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DAVID F. YOCKEY
PRIMARY EXAMINER

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January 18, 2001